



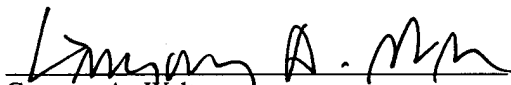
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

Assignee's Docket No.: 8573)
Group Art Unit: 2154)
Serial No.: 09/691,553)
Examiner: Haresh Patel)
Filing Date: October 18, 2000)
Title: Self Service Terminals)

CERTIFICATE OF MAILING

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Gregory A. Welte

CORRECTED APPEAL BRIEF
A Summary of Argument Begins on Page 8

The fee for this Brief may be billed to Deposit Account 14 - 0225, NCR Corporation.

1. REAL PARTY IN INTEREST

NCR Corporation.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF CLAIMS

Claims 1 - 38 have been cancelled.

Claims 39 - 47 are pending, rejected, and appealed.

4. STATUS OF AMENDMENTS

No Amendment-After-Final has been submitted.

5. SUMMARY OF CLAIMED SUBJECT MATTER

A bank may operate a self-service terminal (SST), such as an automated teller machine (ATM) 14a in Figure 1. A "Third Party," such as an airline, may wish to present information on the ATM, such as flight schedules or advertising. (Specification, page 1, lines 9, 10; page 3, line 6 et seq.; server 12 in Figure 1 is under control of that third party.) A web browser 36 in Figure 2 gains access to the Internet 16, to thereby reach the server 12, where the advertising/schedules are stored. (Specification, page 9, lines 12 - 18.)

A user of the ATM has two options: (1) use the ATM as an ATM or (2) use the ATM as a web browser. (Specification, page 11, line 18 - page 12, line 20.) Thus, the web browser function is isolated from the ATM functions.

If the user wishes to obtain a print-out of material, such as advertising, obtained from the web site in server 12 in Figures 2 and 4, the web site can send a print request to the ATM 14a. The ATM 14a is assigned an IP address, which is an address on the Internet, similar to a URL, Uniform Resource Locator. For example, the address www.uspto.gov is a URL.

That IP address at the ATM is termed a "port." When the ATM

14a receives a print request at that "port," a small program, termed a "servlet" executes the printing function. But the ATM software is not involved. (Specification, page 15, lines 4 - 27; page 17, lines 17 - 25.)

The user is only allowed to reach certain web sites.
(Specification, page 17, lines 9 - 12.)

In one embodiment, only the remote application is allowed to perform printing. Thus, if the ATM wishes to perform printing, it must request the remote application to issue a print request. (Page 5, lines 24, 25; page 15, lines 7 - 9.)

Mapping of Claim Elements in Independent Claims

Parenthetical phrases, in **bold typeface**, are inserted into the following independent claims, to identify matter in the Specification and Figures which supports the claim language adjacent said **bold, parenthetical typeface**.

39. A method of operating a self-service terminal (**ATM 14a, Figures 1 and 3**) having a number of peripheral devices (**page 9, lines 22 - 24; devices 50, 52, 54, 56, and 58, Figure 3**) and a terminal application which controls the peripheral devices (**item 34, Figure 3; page 9, line 25 et seq.**), the method comprising the steps of:

presenting to a self-service terminal user an

option of accessing a remote third party application to obtain a service from the third party application while the user is at the self-service terminal (**page 11, lines 18 - 27; page 12, line 20 et seq.**);

receiving a request from the third party application to use one of the peripheral devices of the self-service terminal in response to the user accessing the third party application to obtain the service from the third party application (**page 15, line 4 - page 16, line 17**);

using the terminal application to determine if the request received from the third party application should be granted (**page 15, lines 17 - 27**); and if so

activating the peripheral device under control of the terminal application such that control of the peripheral device is not passed to the third party application when the request from the third party application to use the peripheral device is granted, and thereby to allow the user to obtain the service via the peripheral device (**page 17, lines 17 - 25**).

42. A self-service terminal (**ATM 14a, Figure 1; page 8, line 24 et seq.**) comprising:

one or more peripheral devices (**devices 50,**

52, 54, 52, 56, and 58 in Figure 3; page 9, lines 22 - 24);

a terminal application which controls the peripheral devices (controller 34, Figure 3; page 9, line 25 et seq.; page 9, lines 12 - 16; application 38, Figure 3); and

a controller (servlet 104; page 15, lines 5 - 7 and 21 - 27) for

(i) receiving a request from a remote third party application to use a selected peripheral device in response to the user accessing the third party application to obtain a service from the third party application while the user is at the self-service terminal (page 15, lines 4, 5),

(ii) using the terminal application to determine if the request received from the third party application should be granted (page 15, lines 17 - 27), and if so

(iii) activating the selected peripheral device under control of the terminal application such that control of the peripheral device is not passed to the third party application at any time (page 17, lines

17 - 25).

45. A self-service terminal (ATM 14a, Figure 1; page 8, line 24 et seq.) comprising:

a cash dispenser (dispenser 58, Figure 3; page 5, lines 22 - 24) for dispensing cash to a self-service terminal user conducting a self-service cash dispensing transaction (page 12, lines 1 - 4);

a peripheral device for presenting information to the user (page 9, lines 22 - 24; devices 50, 52, 54, 52, 56, and 58 in Figure 3);

a memory storing a terminal application which controls the peripheral device (Figure 3: controller 34, ATM application 38, main memory 74, storage 76; page 9, line 25 - page 10, line 6; page 10, lines 11 - 12); and

a processor (CPU 72, Figure 3; page 10, lines 3, 4) for

(i) receiving a request from a remote third party application (page 2, lines 7, 8) which is different from the terminal application to use the peripheral device to present third party information to the user (page 15, lines 4 - 16; page 12, lines 3 -

7),

(ii) determining if the request from the third party application should be fulfilled (page 15, line 17 - 27), and if so

(iii) using the peripheral device under control of the terminal application such that control of the peripheral device is not passed to the third party application at any time to present the user with the third party information and thereby to fulfill the request (page 5, lines 14 - 20; page 16, lines 6 - 11; page 17, lines 17 - 25).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The rejection of claims 39 - 47 on grounds of anticipation under 35 USC § 102, based on Ramachandran-Diebold.

The rejection of claims 39 - 47 on grounds of anticipation under 35 USC § 102, based on DeLeo.

The rejection of claims 39 - 47 on grounds of anticipation under 35 USC § 102, based on Drummond.

7. ARGUMENT

SUMMARY OF ARGUMENT

Point 1

All claims have been rejected three times, in three separate
102 - rejections, which rely on three different references.

Claim 39 states that

- 1) a customer, at a terminal (SST), accesses
a remote third party application,
- 2) the third party application makes a
"request" to use a peripheral device of the
SST,
- 3) a determination is made on whether to
perform the request, and
- 4) the request is performed, without
granting control of the peripheral to the
third party application.

As explained herein, **NONE** of these four claim recitations
are found in **ANY OF THE THREE REFERENCES**.

The absence of a **single** claim recitation from the references
is sufficient to preclude the 102 - rejection.

This applies to the remaining independent claims.

Point 2

In Appellant's previous Amendment, he requested that the PTO

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specifically identify these claim elements in one of the references (Drummond):

- 1) The remote third party application,
- 2) The "service,"
- 3) The "request,"
- 4) The "peripheral device" which is
"activated," and
- 5) The determination of whether the
"request" should be granted.

To date, no response has been received from the PTO.

END SUMMARY

ARGUMENT

**Argument re: Rejection of Claims 39 - 47 on
Grounds of Anticipation Under 35 USC § 102,
Based on Ramachandran-Diebold ("R-D"
herein).**

Claims 39 - 47 were rejected on grounds of anticipation, based on Ramachandran, who has Diebold as Assignee. The Office Action designates the reference as "Ramachandran-Diebold," which will be abbreviated "R-D" herein.

Claim 39

Point 1

Claim 39 recites receiving a request from a **remote** third

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party application. Almost all of column 7 of R-D is cited to show this request. (Final Office Action, page 4, fourth line from bottom.)

However, R-D's column 7 merely discusses data stored remotely from an ATM, Automated Teller Machine. That data includes

- 1) data which serves to identify customers, such as passwords (column 7, lines 1 - 7),
- 2) audio and video instructions to be given to customers (column 7, lines 20 - 31),
- 3) financial data about customers' accounts (column 7, lines 8 - 19), and
- 4) advertising-type data (column 7, line 33 et seq.)

None of that shows "receiving a request from the (remote) third party application to use one of the peripheral devices of the self-service terminal" as claimed.

The absence of this recitation, by itself, is sufficient to preclude the rejection. MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Point 2

The claim states that the "request" is in response to a user's accessing the remote third party application.

The Office Action asserts that this accessing of the third party application is shown at two locations.

LOCATION 1

The first location is column 2, lines 19 - 59. (Final Action, page 4, seventh line from bottom.) However, that location contains

- 1) objects of the R-D invention and
- 2) before the objects, two stated purposes of the R-D invention.

As to item (2), the two stated purposes are to

- A) increase security and
- B) market products to users.

Neither of those show accessing a remote third party application by the customer, as claimed.

As to item (1), the objects of the R-D invention are listed at column 2, lines 29 - 59. The objects are to provide a financial terminal which

- identifies customers;
- gives instructions to customers;
- gives advertising to customers;

- selectively gives advertising to customers;
- gives multi-media presentations to customers; and
- dispenses items other than cash.

Clearly, no accessing of a remote third-party application by a customer is shown.

Location 1 fails to show the claim recitation in question, namely, that the "request" is in response to a user's accessing the remote third party application.

LOCATION 2

The second location is column 4, line 60 - column 5, line 14. (Final Action, page 4, seventh line from bottom.) However, that passage merely describes a generic ATM.

Clearly, no accessing of a remote third-party application by a customer is shown.

Thus, as so far discussed, two claim recitations are absent from the R-D reference.

The 102 - rejection cannot stand.

Point 3

The claim states that a "peripheral" is activated to perform the request, without control of the peripheral passing to the

third party application.

The Office Action cites column 14, line 38 - column 15, line 46 of R-D to show this. (Final Action, page 5, lines 2, 3.)

However, this passage shows nothing of the kind.

-- It states that a "thank you message" is displayed.

-- It states that customers can review their transaction, and collect items dispensed.

-- It describes events which occur in the terminal if the customer leaves.

-- It states that instructions can be given in different ways, to different customers, such to deaf persons.

-- It states that different advertising can be given to different customers.

Therefore, the claim recitation has not been shown in R-D.

Conclusion

Three claim recitations are absent from the R-D reference.
The claim states that

- 1) a customer, at a terminal (SST), accesses a remote third party application,
- 2) the third party application makes a "request" to use a peripheral device of the

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SST, and

3) the request is performed, without granting control of the peripheral to the third party application.

As just explained, none of these three recitations are shown in the R-D reference.

MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

In addition, the claim states that a determination is made at the SST as to whether the request should be granted. That has not been shown in the reference.

Remaining Independent Claims

The discussion above applies to the remaining independent claims.

Dependent Claims

The dependent claims are seen as patentable, based on their parents.

Response to Final Action

Point 1

The Final Action, pages 2 and 3, paraphrases arguments made in Appellant's previous Amendment (mailed July 30, 2007).

Those arguments asserted that R-D fails to show certain claim recitations. Most, if not all, of those arguments are set forth above.

Then the Final Action, page 3, first full paragraph, attempts to rebut those arguments. However, the attempted rebuttal, in essence, does nothing more than assert that R-D **implies** the missing claim recitations to a person skilled in the art.

But the attempted rebuttal merely sets form an unsupported conclusion. No evidence has been given in support of the attempted rebuttal. Evidence is required.

Appellant further responds as follows.

Point 2

The Final Action is asserting that certain claim recitations are inherent in the reference. MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the

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determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

No such "basis in fact and/or technical reasoning" has been provided.

Point 3

For a reference to be anticipatory under section 102, the reference must be enabling. (See Patents by D. Chisum, sections 3.06(1)(a) and 304(1).)

The Final Action has not shown anything in R-D which enables the claims.

Point 4

37 CFR § 1.104(c)(2) states:

. . . .

When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

The Final Action asserts that the missing claim recitations are supplied by "reasonable inference" (Final Action, page 3, first full paragraph, line 4), or other implication.

This CFR section requires chapter-and-verse citation of the

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basis for the inference in the R-D reference. That is, the **"particular part relied on"** to support the inference must be **designated**.

That has not been done.

Point 5

It is axiomatic that, for R-D to **anticipate** the claims, R-D must **infringe** the claims. (See PATENTS, A Treatise on the Law of Patentability, Validity, and Infringement, by D. Chisum, section 3.02[1], entitled, "The Classic Infringement Test.")

The Final Action must **SHOW** the infringement.

That has not been done.

**Argument re: Rejection of Claims 39 - 47 on
Grounds of Anticipation Under 35 USC § 102,
Based on Deleo.**

Claims 39 -. 47 were rejected on grounds of anticipation,
based on DeLeo.

Claim 39

As explained above, claim 39 states that

- 1) a customer, at a terminal (SST), accesses
a remote third party application,
- 2) the third party application makes a
"request" to use a peripheral device of the

SST,

- 3) a determination is made on whether to perform the request, and
- 4) the request is performed, without granting control of the peripheral to the third party application.

Point 1

To show the accessing of the remote third party application, the Office Action cites column 3, lines 2 - 48. (Final Action, page 7, second line from bottom.) However, that merely discusses an ordinary ATM. No remote third party application is shown.

Point 2

To show the "request" from the third party application, the Office Action cites column 4, lines 8 - 51. (Final Action, page 8, line 1.) However, that passage only discusses communication between a host 12 and stations 14. No "request" is mentioned.

Point 3

To show the determination of whether to grant the request, the Office Action cites column 7, lines 31 - 64. (Final Action, page 8, line 3.) However, that passage discusses determining whether a "transaction request" by the ATM should be granted.

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(Column 7, lines 19, 20.)

That is the wrong request, for at least two reasons. One reason is that the claimed request is made by the remote third party application which the customer accessed. The request in DeLeo is made by the ATM.

A second reason is that the wrong agency is making any determination as to that request. The claim states that the "terminal application" (in the ATM) makes the determination. In DeLeo, the **request** is made by the ATM. Thus, the **recipient of the request** must make the determination. Consequently, no "terminal application" within the ATM makes the determination, as claimed. Some remote server does, contrary to the claim.

Point 4

To show performance of the request without granting control, the Office Action cites column 8, lines 5 - 58. (Final Action, page 8, line 7.) However, nowhere does that passage discuss processing the claimed request.

And, as stated above, the claimed "request" has not been shown in DeLeo, so the claimed processing of that (missing) **request** is not shown either, let alone processing without passing control.

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Conclusion

At least four claim recitations are absent from the DeLeo reference. Any one of those absences is fatal to the 102 - rejection.

Remaining Independent Claims

The discussion above applies to the remaining independent claims.

Dependent Claims

The dependent claims are seen as patentable, based on their parents.

**Argument re: Rejection of Claims 39 - 47 on
Grounds of Anticipation Under 35 USC § 102,
Based on Drummond.**

Claims 39 - 47 were rejected under section 102, based on Drummond.

Claim 39

As explained above, claim 39 states that

- 1) a customer, at a terminal (SST), accesses a remote third party application,
- 2) the third party application makes a

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"request" to use a peripheral device of the
SST,

3) a determination is made on whether to
perform the request, and

4) the request is performed, without
granting control of the peripheral to the
third party application.

Overview of Reliance on Drummond

The rejection relies on paragraphs 55 - 66 of Drummond.
(Final Action, page 11, first paragraph.)

Point 1

To show the accessing of the remote third party application,
the Office Action cites paragraphs 55 - 59. (Final Action, page
11, line 1.)

However, those paragraphs state

-- what ordinary ATMs do,
-- that Drummond's invention does something
in addition.

However, no accessing of a remote third party application by a
customer is shown.

Point 2

To show the "request" from the third party application, the Office Action cites paragraphs 58 - 60. (Final Action, page 11, line 3.)

These paragraphs may mention instructions sent to an ATM which, for example, order the ATM to perform printing.

But they do not state that the instructions are done by a remote third party application which was accessed by the customer.

Point 3

To show the determination of whether to grant the request, the Office Action cites paragraphs 61 - 63. (Final Action, page 11, line 5.)

However, those paragraphs do not discuss the request claimed. The claimed request is from a remote third party application which the customer accessed. That is not shown in these paragraphs.

Point 4

To show performance of the request without granting control, the Office Action cites paragraphs 64 - 66. (Final Action, page 11, end of first paragraph.)

However, those paragraphs, taken with the other paragraphs

cited, indicate that some remote application can unilaterally issue a command to a peripheral, such as a printer, at an ATM.

That is contrary to the claimed recitation of the SST making a determination of whether to grant the request.

That is also contrary to the claimed recitation that the request itself was issued in response to a prior request by a customer at the ATM.

Conclusion

At least four claim recitations are absent from the Drummond reference. Any one of those absences is fatal to the 102 - rejection.

Appellant's Previous Request

Appellant made a request in his previous response to the PTO. (Amendment mailed July 30, 2007, page 30.) Appellant requested, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify in Drummond these claim elements:

- 1) The remote third party application,
- 2) The "service,"
- 3) The "request,"
- 4) The "peripheral device" which is
"activated," and
- 5) The determination of whether the

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"request" should be granted.

To date, no response has been received from the PTO.

CONCLUSION

Appellant requests that the Board reverse the rejections and pass all claims to issue.

Respectfully submitted,


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ATTACHMENTS: -- CLAIMS APPENDIX,
-- STATEMENT THAT NO EVIDENCE APPENDIX IS
ATTACHED,

and

-- STATEMENT THAT NO RELATED PROCEEDINGS APPENDIX
IS ATTACHED

8. CLAIMS APPENDIX

39. A method of operating a self-service terminal having a number of peripheral devices and a terminal application which controls the peripheral devices, the method comprising the steps of:

presenting to a self-service terminal user an option of accessing a remote third party application to obtain a service from the third party application while the user is at the self-service terminal;

receiving a request from the third party application to use one of the peripheral devices of the self-service terminal in response to the user accessing the third party application to obtain the service from the third party application;

using the terminal application to determine if the request received from the third party application should be granted; and if so

activating the peripheral device under control of the terminal application such that control of the peripheral device is not passed to the third party application when the request from the third party application to use the peripheral device is granted, and thereby to allow the user to obtain the service via the peripheral device.

40. The method according to claim 39, further comprising the step of:

monitoring terminal usage during operation of the third party application to ensure that the user is still present.

41. The method according to claim 39, further comprising the step of:

sending a response to the third party application to indicate the status of the request received from the third party application.

42. A self-service terminal comprising:

one or more peripheral devices;
a terminal application which controls the peripheral devices; and
a controller for

(i) receiving a request from a remote third party application to use a selected peripheral device in response to the user accessing the third party application to obtain a service from the third party application while the user is at the self-service terminal,

(ii) using the terminal application to

determine if the request received from the third party application should be granted, and if so

(iii) activating the selected peripheral device under control of the terminal application such that control of the peripheral device is not passed to the third party application at any time.

43. The self-service terminal according to claim 42, wherein the peripheral device includes a user input device.

44. The self-service terminal according to claim 42, wherein the peripheral device includes a display device.

45. A self-service terminal comprising:

a cash dispenser for dispensing cash to a self-service terminal user conducting a self-service cash dispensing transaction;

a peripheral device for presenting information to the user;

a memory storing a terminal application which controls the peripheral device; and

a processor for

(i) receiving a request from a remote third party application which is different from the terminal application to use the peripheral device to present third party information to the user,

(ii) determining if the request from the third party application should be fulfilled, and if so

(iii) using the peripheral device under control of the terminal application such that control of the peripheral device is not passed to the third party application at any time to present the user with the third party information and thereby to fulfill the request.

46. The self-service terminal according to claim 45, wherein the peripheral device includes a user input device.

47. The self-service terminal according to claim 45, wherein the peripheral device includes a display device.

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9. EVIDENCE APPENDIX

None.

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10. RELATED PROCEEDINGS APPENDIX

· None.